Appln. No. 09/875,998   Docket No. 35-0016

REMARKS

Claims 1-21 were submitted for examination and, in the aforementioned Office action, were rejected as allegedly unpatentable under 35 U.S.C. §102(b) over US Pat. No. 5,075,847 to Fromme, and under 35 U.S.C.§101. The claims have been amended in an effort to obviate these rejections. In particular, claims 1-21 have been canceled and new claims 22-26 are submitted for the Examiner's consideration and examination.

The abstract of the disclosure was "objected to because it does not appear to depict the cursory inspection the nature and gist of the technical disclosure and shall not be used for interpreting the scope of the claim." The nature of the Examiner's objection is not completely understood from this comment, but the abstract has been edited in an effort to improve clarity, and the reference numerals have been removed as requested. If the Examiner has any remaining concerns about the abstract, Applicant is willing make further revisions as needed.

It is noted that the Office action includes, on pages 3-5, printed material defining the Office-recommended format for "Content of Specification." Applicant is unsure why this material was quoted in the Office action because there do not appear to be any specific objections to the specification, other than the objection to the abstract.

Claims 1-21 were rejected under 25 U.S.C. §101 "because they disclose a claimed invention that is an 'abstract idea' as defined in the case of *In re Warmerdam*, 33 F.3d 1354, 31, USPQ2d 1754 (Fed. Cir. 1994)." The Examiner further states that "Applicant presents no substance upon which the claimed invention acts .. and the examiner believes the invention represents a purely abstract idea ...." The Examiner

5

Appln. No. 09/875,998   Docket No. 35-0016

also notes that claims 4, 12 and 20 are system claims in which "a tool provider" including "a development team" is recited.

The Examiner's comments with respect to the inclusion of "a tool provider" in the system claims are noted with appreciation. Obviously, inclusion of possibly human claim elements in the system claims was not intended. To avoid any possible difficulty in this regard, Applicant has canceled the system claims entirely and has submitted a new set of method claims (22-26).

As defined in the amended claims, the invention is directed to a method for generating and providing for customer use, a customized software tool. Although the method manipulates software modules and is performed in conjunction with various computers, it fulfills a useful and practical application; namely, the generation of a customized software tool that satisfies the particular needs of a customer. Without the invention, each customer would have to generate its own customized software tool and there would be much unneeded duplication of effort. In accordance with the invention, a tool provider receives the customer requirements and develops a customized software tool, storing it on a server to facilitate remote use by users at the customer site. Applicant believes that the language from *In re Warmerdam* quoted by the Examiner, and the holding of that case, have in part been undercut by the later decision of the Federal Circuit in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998). After *State Street*, it is believed to be the case that a software method is statutory if one can show that the method produces a useful, concrete and tangible result. In *State Street*, the useful result was the manipulation of data to provide financial services. In the present invention, the useful, concrete and

6

Appln. No. 09/875,998   Docket No. 35-0016

tangible result is providing software customization and maintenance services to meet

uniquely different customer requirements. Accordingly, Applicant's position is that the

remaining method claims are statutory and should not be subject to rejection under 35

U.S.C. §101.

Claims 1-21 were also rejected under 35 U.S.C. §102(b) as allegedly

unpatentable over Fromme (US 5,075,847). The Fromme patent is directed to a

method and apparatus for computer program "encapsulation." Fromme discloses how

a computer-aided software engineering (CASE) system may be integrated with an

"application tool" by a process he terms "encapsulation," even when the CASE system

is available only in binary code form. Although there are similarities between the

Fromme disclosure and the present invention, it is believed that the invention is

distinguishable from Fromme in that the present invention involves a step of developing

a customized software tool based on the customer requirements and using an available

set of system engineering software modules. This development process involves the

use of a development team to develop (i.e., design) the appropriate customized

software tool. Fromme appears to disclose a fully automated process in which a CASE

system is modified by the encapsulation of application-specific requirements, without

reaching into the CASE system software.

More specifically, the Examiner points to FIGS. 3 and 4 and column 3, lines 23-

33, to purportedly show that Fromme discloses the "tool provider." FIG. 3 simply shows

the relationship between a development tool (a build tool), a message server, and a

user interface (X-Window system). The relevance of this figure to the "tool provider" or

the developing step is not fully understood. Similarly, FIG. 4 merely shows that the

7

Appln. No. 09/875,998   Docket No. 35-0016
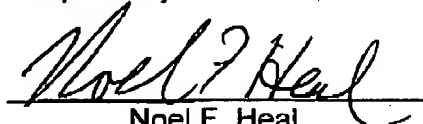
various development tools communicate with each other through a message server. Again, the relevance of this figure is not understood. The cited text in column 3, lines 23-33, describes how an application tool may be located on a local host computer or on a remote host computer. Again, the relevance of this paragraph to the previously claimed "tool provider" is not fully understood.

The other specific instances of reliance on Fromme pertain more to the original claim language and seem less pertinent to the claims as now amended. In particular, claim 22 now contains a step of "providing one or more user database modules on the remote server, for use by one or more users associated with the customer, wherein each user utilizes the stored customized software tool for a particular project or activity." The Framme patent does not appear to contemplate such a step. In brief, the newly submitted claims are believed to distinguish patentably over Fromme, and are respectfully submitted for examination.

Respectfully submitted,

Date: August 20, 2004

Noel F. Heal
Registration No. 26,074

Northrop Grumman Space Technology
Intellectual Asset Management
One Space Park, E1/2041
Redondo Beach, CA 90278
Telephone: (310) 812-4910
FAX: (310) 812-2687

8